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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,751	06/22/2001	Steven S. Kantner	55980USA1B.004	7737

7590 03/03/2009
Attention: Robert W. Sprague
Office of Intellectual Property Counsel
3M Innovative Properties Company
P.O. Box 33427
St. Paul, MN 55133-3427

EXAMINER

KANTAMNENI, SHOUBHA

ART UNIT	PAPER NUMBER
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1617

MAIL DATE	DELIVERY MODE
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03/03/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/887,751

Applicant(s)

KANTNER ET AL.

Examiner

Shobha Kantamneni

Art Unit

1617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) NONE is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/15/2009 has been entered.

The rejection of claims 1-8, 11-13 under 35 U.S.C. 102(f) is herein withdrawn, since application has submitted ROI N02835 showing the conception and reduction to practice of the claimed invention.

Currently claims 1-8, 11-13 are pending, and are examined herein.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4, 6-8, and 11-13 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for specific copolymers with the specific monomers (i), (ii) as in claims 2, 3, and hydrophilic monomers such as (meth)acrylic acid, N-vinyl-2-pyrrolidone in the personal or cosmetic composition, does not reasonably provide enablement for copolymers with any or all hydrophilic monomers.

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The instant specification fails to provide information that would allow the skilled artisan to fully practice the instant invention without undue experimentation. Attention is directed to *In re Wands*, 8 USPQ2d 1400 (CAFC 1988) at 1404 where the court set forth the eight factors to consider when assessing if a disclosure would have required undue experimentation. Citing *Ex parte Forman*, 230 USPQ 546 (BdApl 1986) at 547, the court recited eight factors:

(1) the nature of the invention; (2) the state of the prior art; (3) the relative skill of those in the art; (4) the predictability or unpredictability of the art; (5) the breadth of the claims; (6) the amount of direction or guidance presented; (7) the presence or absence of working examples; and (8) the quantity of experimentation necessary.

(1). The Nature of the Invention:

The rejected claims are drawn to a cosmetic or personal care article comprising an aqueous emulsion or dispersion comprising a genus of copolymers made up of (i) (meth)acrylate ester of C4 to C18 straight/branched chain alcohol, (ii) (meth)acrylate ester of cyclic alcohol, and (iii) hydrophilic monomer.

(2). Breadth of the Claims:

The complex nature of the subject matter of this invention is greatly exacerbated by the breadth of the claims. The claims encompass a copolymer having (i) (meth)acrylate ester of C4 to C18 straight/branched chain alcohol, (ii) (meth)acrylate

ester of cyclic alcohol, and (iii) any hydrophilic monomer unit. The scope of the copolymers in the composition claimed to be useful is extremely broad.

(3). Guidance of the Specification : (4). Working Examples:

The specification lists the preferred monomers for (i), (ii), and provides some examples of hydrophilic monomers that can be employed.

The specification merely provides examples of copolymers with 2-ethylhexyl acrylate, isobornyl acrylate, and acrylic or methacrylic acid. See page 16, Table 1; page 19, Table II of instant specification. The specification provides T_g, tack, and flexibility data for these copolymers with particular amounts of monomers.

(5). State of the Art / Predictability of the Art:

The relative skill of those in the art is high with respect to employing specific copolymers in the instant recited cosmetic or personal care article.

It is well established that the **scope of enablement** varies inversely with the degree of unpredictability of the factors involved. In the instant case, the claimed invention is highly unpredictable since one skilled in the art cannot fully describe the genus, visualize or recognize the identity of the claimed subject matter, except those particular monomers disclosed in the specification by name. In the absence of fully recognizing the genus herein, one of skill in the art is unable to fully predict properties of the copolymers such as T_g, tack and flexibility of copolymer in the claimed composition herein. Moreover, one of the skills in the art would recognize that it is highly unpredictable in regard to the T_g, tack and flexibility of the copolymers obtained from any or all hydrophilic monomers. The recitation hydrophilic monomers includes any

monomer with hydroxyl, ether, amide, amine, and carboxylic, sulfonic or phosphonic acid functionality which includes thousands of monomers. For example, hydrophilic polyethylene oxide containing monomers when employed in specific amount will result in copolymers with different Tg's, tack, and flexibility compared to hydrophilic monomers such as acrylic acid. For example, see instant specification, Comparative Example G, Table II, which employs the instant recited monomers, but provides Tg greater than 35 °C, and fails the flexibility test, and thus does not meet the instant claims 7, and 11. Thus, even varying the amounts of the monomers as in Example 16 versus Comparative Example G, results in different properties for the copolymers.

(7). The Quantity of Experimentation Necessary:

In order to practice the claimed invention, one of ordinary skill in the art would have to first envision a specific monomer (i), (ii), and a hydrophilic monomer, and the amounts of the monomers. One would then need to synthesize the copolymer, and test the copolymer for the required Tg, tack and flexibility. One would then also need to test if the copolymer is compatible in the cosmetic or personal care article. Thus a person of skill in the art would have to engage in undue experimentation to test all the monomers encompassed in the instant claims and their combinations in the claimed composition, with no assurance of success.

Genetech, 108 F.3d at 1366 states that "a patent is not a hunting license. It is not a reward for search, but compensation for its successful conclusion" and "patent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable".

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Claims 1-8, 11-13 are rejected under 35 U.S.C. 102(g) based upon claims 1-4, 6-8 of Rollat et al. Patent No. 6,689,346.

Rollat et al. claims hair styling compositions comprising at least one copolymer comprising (a) from about 20 to about 80 weight percent of units derived from ethyl hexyl (meth)acrylate, (b) from about 5 to about 65 weight percent of units derive from isobornyl acrylate, and (c) from about 1 to about 15 weight percent of units derived from (meth)acrylic acid.

Regarding the recitations of use in the instant claims, it is pointed out that the use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from

the prior art. If the prior art structure is capable of performing the use, then it meets the claim. It is pointed out that the prior art structure such as composition in the form of lotion as in claim 8 of '346 can perform the use such as instant body lotion, since the instant body lotion, and hair styling lotion comprise the same copolymer.

Failure to present claims and/or take necessary steps for interference purposes after notification that interfering subject matter is claimed constitutes a disclaimer of the subject matter. This amounts to a concession that, as a matter of law, the patentee is the first inventor in this country. See *In re Oguie*, 517 F.2d 1382, 186 USPQ 227 (CCPA 1975).

Response to Arguments

Applicant's arguments have been considered, but not found persuasive.

Applicant argues that "Example 20 of applicant's specification gives a typical example of a body lotion formation required to provide a cosmetic product of this nature. Applicants example 20 body lotion formation would not function as a hair shaping composition, such as are described in Rollat et al's example 22, and vice versa." These arguments have been considered, but not found persuasive. First, it is pointed out that instant claim 1 is not limited to example 20. Secondly, page 4 of instant specification teaches that the compositions therein are useful for personal care applications such as hair care products, skin cream, body lotion etc. See instant specification lines 16-18. Accordingly, the hair care lotion as in claim 8 of '346 can perform the use such as instant body lotion, since the instant body lotion, and hair styling lotion comprise the same copolymers.

Regarding, applicant's argument that the instant body lotion is not a reshapable hair styling composition, it is pointed out that in the office action dated 02/22/2007, examiner has rejected the claims under written description requirement for the recitation that the "hair care composition does not have a reshapable effect" , since applicant has not provide any written description as to which of the copolymers/compositions if employed do not provide reshapable effect. Accordingly, applicant arguments are not persuasive.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shobha Kantamneni whose telephone number is 571-272-2930. The examiner can normally be reached on Monday-Friday, between 8 am-4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, Ph.D can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shobha Kantamneni, Ph.D
Patent Examiner

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/SREENI PADMANABHAN/

Supervisory Patent Examiner, Art Unit 1617